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Ravisankar V. Pudipeddi

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WOLF GREENFIELD (Microsoft Corporation)

C/O WOLF, GREENFIELD & SACKS, P.C.

600 ATLANTIC AVENUE

BOSTON, MA 02210-2206

EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RAVISANKAR V. PUDIPEDDI and BRIAN K. DEWEY

Appeal 2009-001875
Application 10/700,729¹
Technology Center 2100

Decided: April 27, 2010

Before JAY P. LUCAS, THU A. DANG, and STEPHEN C. SIU,
Administrative Patent Judges.

LUCAS, *Administrative Patent Judge.*

DECISION ON APPEAL

¹ Application filed November 4, 2003. The real party in interest is Microsoft Corporation.

STATEMENT OF THE CASE

Appellants appeal from a final rejection of claims 1 and 3 to 34 under authority of 35 U.S.C. § 134(a). The Board of Patent Appeals and Interferences (BPAI) has jurisdiction under 35 U.S.C. § 6(b). Claim 2 is cancelled.

We affirm.

The file system filter drivers of a computer are organized in a formation commonly known as a “driver stack.” (*See* Spec. 2, ll. 7-17.) When the computer boots up, its software drivers perform their operations (*e.g.*, scanning file data for viruses, enforcing disk usage quotas, and encrypting data) in a given order corresponding to the stack (*id.*).

Appellants’ invention relates to mapping a number (*i.e.*, “an altitude”) to each filter driver loaded in a computer system. (*See* Spec. 5, ll. 4-6.) When new drivers (*i.e.*, “minifilters”) are added to a stack of legacy system drivers, the method establishes an optimal order for loading all of the drivers. (*See* Spec. 10, ll. 10-14; *but see also* Spec. 4, ll. 5-7.) In the words of Appellants:

This invention permits the filter manager to insert newer “minifilters” between other filters to create a new framework. Working within a legacy filter framework, minifilters can be moved as desired. ... Thus, [the] present invention advantageously enhances the ability of a filter manager to sort incoming requests.

(Spec. 4, l. 28 to 5, l. 2.)

Claims 1 and 13 are exemplary, and are reproduced below:

1. A computer system that facilitates management of a file system filter, comprising:

at least one minifilter that has an integer altitude value associated therewith; and

a filter manager that maps altitudes of the at least one minifilter to legacy filter order groups.

13. A computer implemented method for managing a file system filter, comprising:

loading at least one minifilter to a file system; and

determining an integer altitude value associated with the at least one minifilter.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Golds

US 2001/0020245 A1

Sep. 06, 2001

REJECTIONS

The Examiner rejects the claims as follows:

R1: Claims 1 and 3 to 34 stand rejected under 35 U.S.C. § 101 for being directed to non-statutory subject matter.

R2: Claims 1 and 3 to 34 stand rejected under 35 U.S.C. § 102(e) for being anticipated by Golds.

First, Appellants contend that the claimed subject matter is statutory because the Examiner's determination that the claims be "limited to a practical application within the technological arts lacks support from either 35 U.S.C. § 101 or the Federal Courts' precedential interpretation." (App. Br. 6, middle). Second, Appellants argue that the claimed subject matter is not anticipated by Golds because the reference fails to teach "an integer altitude value," as recited in exemplary claim 1 (App. Br. 8, top). The Examiner contends that each of the claims is properly rejected (Ans. 15, top).

The rejections will be reviewed in the order argued by Appellants. The claims are grouped as per Appellants' Briefs. Only those arguments actually made by Appellants have been considered in this opinion. Arguments that Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

ISSUES

The issues involve whether Appellants have shown that the Examiner erred in rejecting the claims under 35 U.S.C. §§ 101 and 102(e). The first and second of the three issues turn on whether the claimed subject matter is statutory. Specifically, the first issue is whether claim 13 meets the machine-or-transformation test set forth in *In re Bilski*, cited below. The second issue is whether independent claim 1 has a "real-world use" in accordance with the Board's recent precedential opinion, *Ex parte Gutta*, cited below. The third issue specifically turns on whether the Golds reference teaches Appellants' claimed "integer altitude value" of claim 1.

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

Disclosure

1. Appellants have invented a method and system of mapping integer values associated with minifilters to legacy filter order groups (claim 1). Appellants' method involves calculating a number called an "altitude." (See claim 1; Spec. 5, ll. 4-6.)

Golds

2. The Golds reference teaches mapping whole numbers associated with new filter drivers to groups of legacy system filter drivers. (See Figs. 2 and 3; ¶¶ [0030], [0033], [0036], [0038], [0041].)

PRINCIPLES OF LAW

Appellants have the opportunity on appeal to the Board to demonstrate error in the Examiner's position. See *In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006).

The Court of Appeals for the Federal Circuit (CAFC) has recently clarified the law regarding patent eligible subject matter for process claims. *In re Bilski*, 545 F.3d 943 (Fed. Cir. 2008) (en banc). The en banc court in *Bilski* held that "the machine-or-transformation test, properly applied, is the governing test for determining patent eligibility of a process under § 101." *Id.* at 956. The court in *Bilski* further held that "the 'useful, concrete and tangible result' inquiry is inadequate [to determine whether a claim is patent-

eligible under § 101.]” *Id.* at 959-960. The court explained the machine-or-transformation test as follows:

The machine-or-transformation test is a two-branched inquiry; an applicant may show that a process claim satisfies § 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article. *See* [*Gottschalk v. Benson*, 409 U.S. [63, 70 (CCPA 1972)]]. Certain considerations are applicable to analysis under either branch. First, as illustrated by *Benson* and discussed below, the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility. *See Benson*, 409 U.S. at 71-72. Second, the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity. *See* [*Parker v. Flook*, 437 U.S. [584, 590 (1978)]]

Id. at 961-62.

Laws of nature, physical phenomena and abstract ideas are excluded from patent protection. *Diamond v. Diehr*, 450 U.S. 175, 185 (1981).

“[L]imitations are not to be read into the claims from the specification.” *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989)).

“[W]e conclude that [the] claim ... fails to recite any tangible practical application in which the mathematical algorithm is applied that results in a real-world use.” *Ex parte Gutta*, No. 2008-4366, 2009 WL 2563524, at *9 (BPAI 2009) (precedential).

ANALYSIS

From our review of the administrative record, we find that the Examiner presents his conclusions of unpatentability on pages 3 to 10 of the Examiner's Answer. In opposition, Appellants present a number of arguments.

*Argument with respect to the rejection
of claims 1 and 3 to 34
under 35 U.S.C. § 101 [R1]*

Appellants' argument addresses the issue of statutory subject matter under 35 U.S.C. § 101.

Appellants argue: "[The] Examiner's contention that the ... claims must be limited to a practical application within the technological arts lacks support from either 35 U.S.C. 101 or the Federal Courts' precedential interpretation." (App. Br. 6, middle).

We begin the analysis by noting that the "useful, concrete, and tangible result" test (*see State St. Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 1373 (Fed. Cir. 1998)) relied upon by the Examiner in the Answer was later clarified by the decision in *In re Bilski*, cited above. Notwithstanding this observation, we agree with the Examiner.

In light of the CAFC's guidance on statutory subject matter in *Bilski*, cited above, we analyze exemplary independent method claim 13 based upon the machine-or-transformation test. Regarding the machine prong of the *Bilski* test, we interpret the claimed "file system filter" and "minifilter" as reading on software, which is consistent with the disclosure (Spec. 7, ll. 12-14 and 20-21). Further, we broadly construe Appellants' claimed "file system" as reading on any system containing files. This Board places no

further limitation on what “file system” means, represents, or includes, since Appellants chose not to specifically limit the claimed “file system” in any way. Thus, Appellants’ “file system” (claim 13) is tied to no particular machine. Since Appellants’ claimed “filed system” is not tied to a particular machine, claim 13 fails to meet the first prong of *Bilski*.

Regarding *Bilski*’s transformation prong, claim 13 merely recites “determining an integer altitude value.” “[D]etermining an integer altitude value” is synonymous with the calculation of a number, where the number represents a ranking or ordering of the filter drivers. We thus find that Appellants have claimed a method of calculating a number (FF#1). Since Appellants’ claimed “determining” step is merely the calculation of a number (*i.e.*, a mathematical abstraction) (FF#1), we conclude that claim 13 fails to meet the transformation prong of *Bilski*, cited above. (*See also Diamond v. Diehr*, cited above.) Accordingly, we find that “determining an integer altitude value” is not a data transformation (*i.e.*, no “article” is transformed) that meets the second prong of *In re Bilski*. In light of our findings that claim 13 meets neither the machine nor the transformation prong of *Bilski*, cited above, we find no error in the Examiner’s rejection [R1] under 35 U.S.C. § 101 of claim 13.

Next, we consider independent claim 1, which recites a “system.” The claim includes “a filter manager,” “altitudes,” and “at least one minifilter.”

“[W]e conclude that [the] claim ... fails to recite any tangible practical application in which the mathematical algorithm is applied that result[s] in a real-world use.” *Ex parte Gutta*, cited above.

We find that that the algorithms resulting in “at least one minifilter that has an integer altitude value associated therewith” and “a filter manager that maps altitudes of the at least one minifilter” are abstract ideas having no “real-world use” in accordance with the teachings of *Ex parte Gutta*, cited above. That is, where Appellants’ claim merely “maps altitudes,” such activity is merely the assignment of a number (FF#1). We note that no use, in the claim language, is made of this number (*i.e.*, the claimed “integer altitude value”). In light of *Gutta*, Appellants’ claimed “filter manager that maps” fails to meet the statutory subject matter test under 35 U.S.C. § 101 since number assignment alone (*i.e.*, absent any application of the mapping in a useful manner) has no claimed “real-world” value. Further, we treat Appellants’ addition of recited structure (*i.e.*, the claimed “filter manager,” “altitudes,” and “at least one minifilter” of claim 1) to the underlying method of mapping an “altitude” (*i.e.*, a number) (*see* FF#1) as merely a *pro forma* claims drafting technique. These recitations fail to produce any demonstrable real-world effect. To the extent (if any) these recitations represent structural elements, a “filter manager,” “altitudes,” and “at least one minifilter” are merely “insignificant extra-solution activity” or “field-of-use limitations” as described in the *Bilski* decision. *Bilski*, 545 F.3d at 957. In other words, claim 1 is simply a method claim dressed in the form of a system claim. Accordingly, we find no error in the rejection [R1] of claim 1.

*Arguments with respect to the rejection
of claims 1 and 3 to 34
under 35 U.S.C. § 102(e) [R2]*

Next, Appellants contend that the claims “[employ] and [assign] integer values to facilitate ordering of file systems and file system filters,” whereas the Golds reference assigns “floating point values to software modules.” (App. Br. 8, top).

We find unconvincing Appellants’ argument that assigning “floating point values to software modules” is not the same as “at least one minifilter that has an integer altitude value associated therewith,” as recited in exemplary claim 1, for the following reasons. We find that Appellants have claimed a method and system of mapping integer values associated with minifilters to legacy filter order groups (FF#1). In comparison, the Golds reference teaches mapping whole numbers associated with new filter drivers (Appellants’ claimed “minifilters”) to groups (Appellants’ claimed “legacy filter order groups”) of legacy system filter drivers (FF#2). Besides “floating point values” being assigned in Golds, the patent a few lines later also says: “[A]ny system can be used, as long as there are relative values within the system that can be used to determine an order. Note that it is also feasible to implement a scheme wherein whole numbers are used.” (§ [0036]). Thus, the reference teaches employing and assigning whole numbers (and not just floating point values) to facilitate ordering of file systems and file system filters. A person of ordinary skill in the art would have recognized Golds’s teaching of a whole-number scheme of ordering filter drivers (FF#2) as being no different from the use of an “integer altitude value” for “[mapping] altitudes,” as claimed. Thus, we are not persuaded by

Appellants' argument concerning "floating point values." Accordingly, we find no error in the rejection under 35 U.S.C. § 102(e).

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that the Examiner did not err in rejecting claims 1 and 3 to 34 under 35 U.S.C. §§ 101 and 102(e).

DECISION

The Examiner's rejections [R1, R2] of claims 1 and 3 to 34 are affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

peb

WOLF GREENFIELD (MICROSOFT CORPORATION)
C/O WOLF, GREENFIELD & SACKS P.C.
600 ATLANTIC AVENUE
BOSTON, MA 02210-2206